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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,401	09/18/2003	Peter J. Newman	PJN1	4449

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EXAMINER
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WELCH, GARY L

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,401

Applicant(s)

NEWMAN, PETER J.

Examiner

Gary L. Welch

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities: It appears that "19" (page 11, line 16) should be changed to --16--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 requires that the guide pad to have a length insufficient to form an obstruction when used with a second glove having a second raised elongated guide pad. Since only a single glove is being claimed, it is unclear how or by means enables the guide pad to have a length insufficient to form an obstruction. There is no relationship established between a first and second glove since only one glove is claimed to enable one of ordinary skill to make a glove that has a pad that would not obstruct with a second glove having a pad. Additionally, there is no indication where the second pad is located at on the second glove.

Furthermore, if the wearer used a baseball style grip it does not seem possible that the pads of two gloves would obstruct one another. It appears this invention is directed to golf glove to be used with an overlapping type grip.

Claims 2-6 depend from rejected claim 1 and are therefore rejected accordingly under 35 U.S.C. 112, second paragraph.

Claim 7 requires that the guide pad to have a length insufficient to form an obstruction when used with a second glove having a second raised elongated guide pad. In this case, a pair of gloves is being claimed as opposed to claim 1. However, it is unclear how or by means enables the guide pad to have a length insufficient to form an obstruction. There is no relationship established between a first and second glove and the first and second pads to enable one of ordinary skill to make a pair of gloves that has pads that would not obstruct with each other. Furthermore, if the wearer used a baseball style grip it does not seem possible that the pads of two gloves would obstruct one another. It appears this invention is directed to golf glove to be used with an overlapping type grip.

Claims 8-13 depend from rejected claim 7 and are therefore rejected accordingly under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanson (U.S. 4,000,903).

Swanson discloses a golf glove 10 having a palm portion 11, a raised elongated guide pad 17 extending diagonally across a portion of the palm portion between a thumb portion 13 and a finger portion 14 and secured to the palm portion wherein the guide pad 17 is substantially parallel to a transverse crease of a hand and extending across the palm portion of the golf glove for a distance between a first position (Figure 2) corresponding to a first end of the guide pad and a second position corresponding to a second end of the guide pad, the distance being less than substantially all of a breadth of the palm portion and the guide pad has a length insufficient to form an obstruction when used with a second glove having a second raised elongated guide pad.

With regard to claim 3, the first position is about an exterior edge of a forefinger portion of the glove and the second position is about a midpoint of a second finger portion of the glove.

With regard to claim 4, the guide pad 17 comprises a sheath surrounding a core 25 (Figure 4).

With regard to claim 5, the core 25 is cylindrical in shape.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 4,000,903).

Swanson discloses the invention substantially as claimed above. Swanson discloses that the cross-sectional diameter of the pad is approximately 6.35 mm (0.25 inch; Col. 2, lines 57-63).

However, Swanson does not disclose that the cross-sectional diameter is about 8 mm.

A review of the applicant's specification does not reveal any criticality (i.e., why 8 mm is preferable over any other value) for the claimed dimension. In fact, the only mention of the cross-sectional diameter of the pad being 8 mm is found on page 10, lines 8-14 of the specification. This section states that the pad (including the core) should preferably be about 8 mm in diameter.

Therefore, absent some disclosed criticality, it would have been obvious through routine experimentation to provide a pad having the claimed dimension in order to prevent creasing, folding over or collapsing while at the same time being deformable so as to follow the contour of the golfer's hand (Col. 2, lines 48-63) and to fit a variety of golf clubs having differing shaft grip thickness.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 4,000,903) in view of Bach (U.S. 4,329,741).

Swanson discloses the invention substantially as claimed above.

However, Swanson does not disclose that the core is comprised of rigid foam material.

Bach teaches a golf glove having a pad disposed upon the palm portion for properly positioning a golf club thereby ensuring a proper golf swing. The pad is comprised of rigid foam material (Col. 3, lines 10-12). Since the core of Swanson and the pad of Bach are both rigid materials used in positioning a golf club in proper alignment, then they are considered equivalent and therefore it would have been obvious to replace the core material of Swanson with the rigid foam material taught by Bach in order to provide a predetermined level of strength to prevent creasing, folding over or collapsing (see Col. 2, lines 58-63) during use.

***Allowable Subject Matter***

9. Claim 8 and its dependents would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

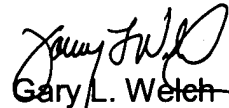
***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cole '678, Stroud '465, Lykins '875 and Link '882 disclose various golf gloves for properly positioning a golf club.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Welch whose telephone number is (703) 305-0451. The examiner can normally be reached on Mon-Fri 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary L. Welch  
Primary Examiner  
Art Unit 3765

glw